Application No.: 10/811,839 Docket No.: 2003133.00125US11 Request for Continued Examination dated 11/17/2008

Reply to Office Action dated 6/17/2008

### REMARKS

#### Priority

Applicant has amended the priority statement in the specification to accurately reflect the chain of priority for the instant application. This application is a continuation-in-part application of PCT/US02/00476. The Examiner has stated that PCT/US02/00476 "is a CON" of 09/771,669. (See Office Action, page 8.) PCT/US02/00476 is a continuation-in-part application of U.S. Application No. 09/771,669, as indicated on the front page of WO 02/060393. Applicant's Transmittal Letter To The United States Receiving Office (Exhibit 1) indicates that the Applicant listed the '669 application as a related application and checked the box that states "The present international application... contains additional subject matter not found in the prior U.S. application(s) identified in paragraph C...." Box VI of the PCT Request (Exhibit 2) also claimed priority to the '669 application. Therefore, PCT/US02/00476 is a continuation-in-part application of the '669 application.

The Examiner has stated that Continuity/Foreign Data Report for the '669 application does not indicate any reference to 09/056,707 (see Office Action, page 8). Applicant believes this is in error. Applicant directs the Examiner's attention to the Related Application Data on the front page of U.S. Patent No. 6,984,667. The '667 patent is a continuation-in-part application of U.S. Application No. 09/056,707, now U.S. Patent No. 6,689,748. Applicant also directs the Examiner's attention to the Bibliographic Data Sheet dated March 7, 2005 on the Patent Application Information Portal ("PAIR") (Exhibit 3). The Data Sheet states "This is a continuation-in-part / divisional application based on United States Serial No. 09/056,707, filed 04/08/1998, now United States Patent No. 6,689,748."

Based upon the above amendments and remarks, Applicant believes the priority claim of the instant application is now correct.

5

US1DOCS 6860479v1

Application No.: 10/811,839 Docket No.: 2003133.00125US11 Request for Continued Examination dated 11/17/2008

Reply to Office Action dated 6/17/2008

#### Claim Amendments

Applicant has canceled claims 39-44 without prejudice or disclaimer and added claims 45-63. Support for these claims can be found throughout the specification. Specifically, support for claim 45 can be found throughout the specification, and, for example, in paragraphs [013] and [024]. No new matter has been added by these amendments.

## Claim Rejections - 35 U.S.C. § 112, 1st Paragraph

The Examiner rejected claims 39 and 42-44 under 35 U.S.C. § 112, 1st paragraph, as allegedly containing new matter. The Examiner stated that the amendment to now-canceled claim 39 was rendered moot by the previous amendment that replaced "protecting" with "treating." (See Office Action, page 9.) However, the Examiner maintained the rejections in dependent claims 43 and 44 (both now canceled) because both claim 43 and 44 recited the term "protecting." (See id.) None of new claims 45-61 recite the term "protecting"; each new claim is directed to either "[a] composition for treating..." or "[a] method of treating..." Applicant believes the new claims satisfy the requirements of 35 U.S.C. § 112, 1st paragraph.

The Examiner also rejected claim 42 under 35 U.S.C. § 112, 1st paragraph, as allegedly not complying with the written description requirement and containing new matter. (See id.) The Examiner alleged that the application did not teach the claimed ranges. (See id.) Applicant has canceled claim 42. Claims 50, 54-55, 57, and 59 include ranges that correspond to the ranges in the specification. Support for the claimed ranges can be found in paragraphs [034] and [037]. Applicant believes these new claims satisfy the requirements of 35 U.S.C. § 112, 1st paragraph.

Based on the foregoing amendments and remarks, Applicant believes the amended claims comply with 35 U.S.C. § 112, 1<sup>st</sup> paragraph.

6

## Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

LISTORY'S ASABATON I

Application No.: 10/811,839 Request for Continued Examination dated 11/17/2008

Reply to Office Action dated 6/17/2008

The Examiner rejected claim 42 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, for purportedly broadening the scope of the claim from which it depended (now-canceled claim 39). Claim 42 has been canceled. Applicant believes the amended claims fully comply with 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Docket No.: 2003133.00125US11

### Claim Rejections - 35 U.S.C. § 103(a)

The Examiner has rejected claims 39-41 as allegedly being unpatentable over cited Lindsberg et al. (U.S. Publication No. 2006/0210551). (See id., page 6.) As noted by the Examiner, the earliest filing date that Lindsberg et al. could claim is February 13, 2003. (See id., page 11.) Applicant has cancelled claims 39-41. However, to the extent the Examiner may apply this prior art rejection to the new claims, because Applicant has amended the priority claim to correctly claim priority back to 1998, Lindsberg et al. cannot be prior art to the instant claims. Applicant respectfully requests that the rejection be withdrawn and not applied to the new claims.

Application No.: 10/811,839 Docket No.: 2003133.00125US11 Request for Continued Examination dated 11/17/2008

Reply to Office Action dated 6/17/2008

## CONCLUSION

Applicant believes the rejections maintained in the Office Action have been overcome and that the application is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued.

A two-month Petition for Extension of Time is filed with this submission. The Director is hereby authorized to charge Deposit Account No. 08-0219, under Order No. 2003133.125US11, the fee of \$245.00 pursuant to 37 C.F.R. § 1.17(a).

The Director is also hereby authorized to charge Deposit Account No. 08-0219, under Order No. 2003133.125US11, the fee of \$405 filed herewith pursuant to 37 C.F.R. § 1.17(e).

Applicant believes no additional fees are due with this Request for Continued Examination and Response to Final Office Action. However, if such a fee is due, or a credit is owed, the Director is hereby authorized to make them to our Deposit Account No. 08-0219, under Order No. 2003133.00125US11.

The Examiner is encouraged to call the undersigned at the telephone number given below to move this application towards allowance.

8

Respectfully submitted,

Colleen Superko

Registration No.: 39,850 Attorney for Applicant

Wilmer Cutler Pickering Hale and Dorr LLP

60 State Street

USIDOCS 6860479v1

Boston, Massachusetts 02109 (617) 526-6000 (telephone)

Dated: November 17, 2008

(617) 526-5000 (facsimile)

Application No.: 10/811,839 Request for Continued Examination dated 11/17/2008 Reply to Office Action dated 6/17/2008 Docket No.: 2003133.00125US11

## EXHIBIT 1

## TRANSMITTAL LETTER TO E UNITED STATES RECEIVING OFFICE

Date	January 2, 2002
International Application .vu.	TBA
Attorney Docket No.	51275/111

I.	Certification under	7 CFR 1.10 (if appli	cable)

Express Mail mailing number Date of Deposit

I hereful certify that the application/correspondence attached hereto is being deposited with the United States Postal Service "Express Mail Post Office in Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Paicuts and Trademarks.

Washington, D. C. 20231

Signature of person mailing correspondence

Typed or printed name of person mailing correspondence

#### II. [KEYBOARD()] New International Application

TITLE: Proteoglycan Compositions For Treatment of Inflammatory
Diseases

Earliest priority date (Day/Month Year) 30 January 2001

SCREENING DISCLOSURE INFORMATION: In order to assist in screening the accompanying international application for purposes of determining whether a license for foreign transmittal should and could be granted and for other purposes, the following information is supplied. (Note: check as many boxes as apply):

- A. | | The invention disclosed was not made in the United States.
- B. 11 There is no prior U.S. application relating to this invention.
- C. [X] The following prior U.S. application(s) contain subject matter which is related to the invention disclosed in the attached international application. (NOTE: priority to these applications may or may not be claimed on form PCT/RO/101 (Request) and this fisting does not constitute a claim for priority).

	<del></del>	
application 09/771.669	application	
annlication	annlication	

- D. [] The present international application [] is identical to [] contains less subject matter than that found in the prior U.S. application(s) identified in paragraph C above.
- E. [X [The present international application [TBA] contains additional subject matter not found in the prior U.S. application(s) identified in paragraph C above. The additional subject matter is found on pages 14 and 15 and [X] DOES NOT ALTER [] MIGHT BE CONSIDERED TO ALTER the general nature of the invention in a manner which would require the U.S. application to have been made available for inspection by the appropriate defense agencies under 35 U.S.C. 181 and 37 CFR 5.1. See 37 CFR 5.15.

## III. | A Response to an Invitation from the RO/US. The following document(s) is(are) enclosed:

- A. | | A Request for An Extension of Time to File a Response
- B. |X| A Power of Attorney (General or Regular)
- C. | Replacement pages:

1	pages	of the request	pages	of the
	pages	of the description	nages	of the
	nages	of the claims	1 8	

- D. | | Submission of Priority Documents
- E. [X] Fees as specified on attached Fee Calculation sheet form PCT/RO/101 annex

# IV. [] A Request for Rectification under PCT Rule 91 [] A Petition [] A Sequence Listing Diskette

V. | | Other (please identify): □ Common X Attorney/Agent (neg. 3.33,649) The person signing this form is the: 

Applicant

Representative Melin Blella Dr. Melvin Blecher Signature Typed name of

signer

Application No.: 10/811,839 Request for Continued Examination dated 11/17/2008 Reply to Office Action dated 6/17/2008 Docket No.: 2003133.00125US11

## EXHIBIT 2

## PCT

### REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference (if desired) (32 characters maximum)

#### Box No. I TITLE OF INVENTION

Proteoglycan Compositions For Treatment of Inflammatory Conditions

## APPLICANT

Name: and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (i.e. country) of residence if no State of residence is indicated below.)

#### THEOHARIDES, Theoharis C.

14 Parkman Street Brookline, MA 02446

U.S.A.

Box No. II

[X] This person is also inventor.

Telephone No. 617-232-1337

Facsimile No. 617-232-1337

Teleprinter No.

State (i.e. country) of nationality: U.S.A.

State (i.e. country) of residence: U.S.A.

This person is applicant for purposes of [X] all designated States; [] the United States only; [ the States indicated in the Supplemental Box

## Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country, The country of the address indicated in this Box is the applicant's State (i.e. country) of residence if no State of residence is indicated below.)

This person is:

applicant only

applicant and inventor

l inventor only (If this check-box is marked, do not till in

State (i.e. country) of nationality:

State (i.e. country) of residence:

This person is applicant for the purposes of: [] all designated States; [] all designated States except the United States of America; [] the United States of America only; [] the States indicated in the Supplemental Box

Further applicants and/or (further) inventors are indicated on a continuation sheet.

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR

The person identified below is hereby/has been appointed to act on common representative of the applicant(s) before the competent International Authorities :			
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)	Telephone No. (202) 363-0373		
I.AW OFFICES OF DR. MELVIN BLECHER 4329 VAN NESS STREET NORTHWEST WASHINGTON, D.C. 20016-5625	Facsimile No. (202) 362-8404		
United States of America per: BLECHER, MELVIN	Teleprinter No.		
[] Mark this check-box where no agent or common representative the space above is used instead to indicate a special address to whi- be sent.	is/has been appointed and ch correspondence should		

Form PCT/RO/101 (first sheet)(January 1997)

See Notes to the request form

## Box No. V DESIGNATION OF STATES

The following designations are hereby made under Rule 4.9(a) (mark the applicable check-boxes; at least one must be marked):
Regional Path

- [] AP ARIPO Patent: KE Kenya, LS Lesotho, MM Malawi, SD Sudan, SZ Swaziland, UG Uganda and any other State which
  is a Contracting State of the Harare Protocol and of the PCT
- [] EA Eurosian Patent: AM Armenia, AZ Azerbaijan, BY Belarus, KG Kyrgyzstan, KZ Kazakstan, MO Republic of Moldowa, RU Russian Federation, Tu Tajikistan, TM Turmenistan, and any other State which is a Contracting State of the Eurosian Patent Convention and of the PCT
- [X] EP European Patent: AT Austria, BE Belgium, CH and L1 Switzerland and Liechtenstein, DE Germany, DK Denmark, ES Spain, FI Finland, FR France, GB United Kingdom, GR Greece, IE Ireland, IT Italy, LU Luxembourg, MC Monaco, NL Netherlands, PT Portugal, SE Sweden, and any other State which is a Contracting State of the European Patent Convention and of the PCT

[] OA DAP! Patent: BF Burkina Faso, BJ Benin, CF Central African Republic, CG Compo, Cl Cáte d'Ivoire, CH Cameroon, CA Gabon, GN Guinea, ML Mail, NR Mauritania, NE Miger, SN Senegal, 10 Chad, 16 Togs, and ary other State which is a member State of OAP! and a Contracting State of the PIC (if other kind of protection or treatment desired; specify on dotted line)

National Patent (if other kind of protection or treatment desired, specify on

National Pa	tent (if other kind of prot ):	ection or t	reatment desired, specify on
I I AL	Albania	[ ] LU	Luxembourg
[] AM	Armenia	[ ] LV	Latvia
I ) AT	Austria	, MD	Republic of Moldova
[X] AU	Australia	[ ] MG	Madagascar
AZ	Azerbaijan	[ ] MK	The former Yugoslav Republic
I BA	Bosnia and Herzegovina		of Macedonia
[ ] BB	Barbados		
[] BG	Bulgaria	[ ] MN	Mongolia
I BR	Brazil	[ ] MW	Malawi
[] BY	Belarus	[X] MX	Mexico
[X] CA	Canada	[ ] NO	Norway
[ ] CH and	LI Switzerland and	[X] NZ	New Zealand
Liechtenste	in	[ ] PL	Poland
[] CN	China	[ ] PT	Portugal
[] CU	Cuba	[ ] RO	Romania
[ ] CZ	Czech Republic	[ ] RU	Russian Federation
[ ] DE	Germany	[ ] SD	Sudan
[ ] DK	Denmark	[ ] SE	Sweden
[ ) EE	Estonia	[ ] SG	Singapore
[ ] ES	Spain	[] SI	Slovenia
[ ] FI	Finland	[ ] SK	Slovakia
[ ] GB	United Kingdom	[ ] TJ	Tajikistan
[ ] GE	Georgia	[ ] TM	Turkmenistan
Hu	Hungary	[ ] TR	Turkey
[ ] IL	Israel	[ ] TT	Trinidad and Tobago
IS	Iceland	[ ] UA	Ukraine
[X] JP	Japan	[ ] UG	Uganda
( ) KE	Kenya	[X] US	United States of America .
[ ] KG	Kyrgyzstan	(This is	a continuation-in-part application
[ ] KP	Democratic People's	for the US)	
	Republic of Korea	( ) UZ	Uzbekistan
[ ] KR	Republic of Korea	[ ] VN	Viet Nam
[] KZ	Kazakstan	Check-boxes	
[ ] rc	Saint Lucia	States (for	r the purposes of a national
[ ] LK	Sri Lanka	patent) whi	ch have become party to the FCT
[ ] LR	Liberia	after issua	unce of this sheet: Yugoslavia
[ ] LS	Lesotho	[ ] GH	Ghana
(-) LT	Lithuania		

KEYEDARD()In addition to the	isig. ons made above, permitted under	the applicant also		ule 4.9(b) all det the designa	signations ition(s)
of					
the applicant declares that	those additional designa	ations are subject !	to confirmation	on and that any d	esignation
which is not confirmed befor	e the expiration of 15 m	onths from the prio	rity date is	to be regarded as	withcrawn
by the applicant at the exp	ration of that time lim	nit. <i>(Confirmatio</i> :	n of a desi	gnation consist	s of the
		a and the nament	of the dock	reation and con-	Ciemarian I

filing of a notice specifying that designation and the payment of the designation and confirmation fees. Confirmation must reach the receiving Office within the 15-month time limit.

Form PCT/RO/101 (second sheet) (January 1997)

See Notes to the request form

Box No. VI I		er priority claims are indica	ted in the
The priority o	f the following earl	ier application(s) is hereby	claimed:
Country (in which, or for which, the application was filed)	Filing Date (day/month/year)	Application No.	Office of filing (only for regional or international application)
item (1) US	30/01/2001	09/771,669	
item (2)			
1 (2)	1		

Mark the following check-box if the certified copy of the earlier application is to be issued by the Office which for the purposes of the present international application is the receiving Office (a fee may be required):

The receiving Office is hereby requested to prepare and transmit to the International Bureau a certified copy of

[X] the earlier application(s) identified above as item(s): (1)

Box No. VII INTERNATIONAL SEARCHING AUTHORITY

Choice of International Searching Authority (ISA) (If two or more International Jearching Authorities are competent to carry out the international search, indicate the Authority choseni the two-letter code may be used): EPO

Barlier search fill in where a search (international international-type or other) by the International Searching Authority has already been carried out or requested and the attenty is now requested to base the international search, to the extent possible, on the results of that earlier search. Identify such search or request either by reference to the relevant application (or the translation thereof) or by reference to the search request: Country (or regional Office): Date (day/month/year): Number:

Box No. VIII CHECK LIST

This international application contains the following number of sheets:  1. request: sheets 4 2. description: sheets 15 3. claims: sheets 5 4. abstract: sheets 1 5. drawings: sheets 0  TOTAL: sheets 25	This international application is accompanied by the item(s) marked below: 1. [] separate signed power of attorney 2. [X] copy of general power of attorney 3. [] statement explaining lack of signature 4. [] priority document(s) identified in Box No. VI as item(s): 5. [X] fee calculation sheet 6. [] separate indications concerning deposited microorganisms 7. [] nucleotide and/or amino acid sequence listing (diskette) 8. [] other (spectfp): 9. [X] Postcard				
Figure No. [ ] of the drawings (if any) shou	ld accompany the abstract when it is published.				
Box No. 1X SIGNATURE OF APPLICANT OR AGENT					
ment to need signetures indicate the name of the person signing and the capacity in which the person signs til such capacity is get obvious from resuling the requests.  Blown (a.m. 02, 2002					

For	rece	iving	Offi	ce	use	only	

1.	Date of actual receipt of the purported international application:	2. Drawings:	
3.	Corrected date of actual receipt due to timely received papers or drawings compl the purported international application:	[ ] not received:	
4.	Dute of timely receipt of the required corrections under PCT Article 11(2):		
	International Searching Authority specified by the applicant:	6. [ ] Transmittal of search copy delayed until search fee is paid	

For International Bureau use only

Date of receipt of the record copy by the International Bureau:

Form PCT/RO/101 (last sheet) (January 1994; reprint Januarynd 1997) to the request form

Application No.: 10/811,839 Request for Continued Examination dated 11/17/2008 Reply to Office Action dated 6/17/2008 Docket No.: 2003133.00125US11

## EXHIBIT 3



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United Status Patent and Trademark Office
Address COMMISSIONER FOR PATENTS
FO. Bar 1499 in 22013-1459
oversigned

## 

Dib Date Chest

**CONFIRMATION NO. 8174** 

SERIAL NUME 09/771,669		FILING DATE 01/30/2001 RULE		CLASS 514	GROUP AR 1615		DOC	TORNEY CKET NO. 275/107
APPLICANTS								
		eoharides, Brookline, N						
"continuing data								
** 03/26/2001				1				
Foreign Priority claime 35 USC 119 (a-d) cond met		yes on o Metafte	er .	STATE OR	SHEETS	TOTAL	LINE	DEPENDENT
Verified and Acknowledged	Exa	Allowance Howard miner's Signature Init	ials	COUNTRY MA	DRAWING 0	CLAIM: 21	s	CLAIMS 8
ADDRESS 28538 DR. MELVIN BLECHER 4329 VAN NESS ST., NW WASHINGTON , DC 20016								
TITLE SYNERGISTIC PROTEOGLYCAN COMPOSITIONS FOR INFLAMMATORY CONDITIONS								
FILING FEE FEES: Authority has been given in Paper Noto charge/credit DEPOSIT ACCOUNT Nofor following:    All Fees     1.16 Fees (Fitting)     1.17 Fees (Processing Ext. of time)     1.18 Fees (Issue)     Other							ng Ext. of	

			Page 2 of 2
		☐ Credit	
	***************************************		